

REMARKS

I. INTRODUCTION

Claims 1-47 have been previously cancelled, without prejudice. Claims 48, 54, 56, 62, 68-70, 76, 84 and 90 have been amended above to remove minor informalities therefrom, and not for any reason relating to patentability thereof. New claims 98-107 have been added. Claims 48-108 are under consideration in the above-referenced application. Provided above, please find a claim listing indicating the current amendment to the previously-pending claims on separate sheets so as to comply with the requirements set forth in 37 C.F.R. § 1.121. It is respectfully submitted that no new matter has been added.

II. INFORMATION DISCLOSURE STATEMENT

In the Office Action, the Examiner confirms that the information submitted with the Information Disclosure Statement filed for the above referenced application have been considered as to the merits. Applicants appreciate the consideration of all submitted materials by the Examiner.

However, the Examiner then states that the number of references and materials listed in the submissions that accompanied the previously-submitted Information Disclosure Statements by Applicants “make it difficult to determine whether or not any of the references, or parts of the references, are material to applicants’ claimed invention. It is noted that applicants, in their several IDS submissions, do not indicate any particular reference or parts of references which they deem ‘material’ to the patentability of the pending claims under 37 CFR 1.56(b).” (Office Action, p. 2, Ins. 7-12).

It is well established that Applicants are only required to disclose to the U.S. Patent and Trademark Office (the "Patent Office") "all information known to ... [all] individual[s] identified in 37 C.F.R. 1.56(a)] to be material to patentability ... [of the claims of the application as defined in 37 C.F.R. 1.56]." 37 C.F.R. 1.56(a). There is no requirement in this section or any other section of 37 C.F.R. to specifically identify which references (and/or parts thereof) Applicants deem to be material to patentability of the claims pending in the above-identified application. Indeed, while 37 C.F.R. 1.56(a) provides that "[t]here is no duty to submit information which is not material to the patentability of any existing claim," there is nothing in this section which precludes the submission of any information which may not be material to the patentability of any pending claims in the subject application.

Clearly, Applicants are under no known duty to specifically identify to the Patent Office which references (and/or portions thereof) are material to the patentability of any pending claim of this application. Indeed, Applicants clearly complied with the requirements set forth in 37 C.F.R. § 1.56 by providing to the Patent Office all references which may relate to the claims of the above-referenced application, whether they are material or immaterial to the patentability of any of the pending claims. It appears that the Examiner is inappropriately seeking to impart an additional duty on Applicant where no such duty legally exists.

Next, the Examiner refers to *J.P. Steven & Co. v. Lex Tex Ltd.*, 747 F.2d 1553, *cert. denied*, 106 S.Ct. 73(1973) as describing one of the standards for an inequitable conduct before the Patent Office. However, this case has absolutely nothing to do with the situation when all references and information known to Applicant have been cited to the Patent Office, and relates to a case when a material reference was not cited to

the Patent Office. The present situation is completely different, and indeed factually opposite to the *J.P. Stevens* case. The Examiner, apparently improperly using the holding of this case, again attempts to impose additional burdens on Applicants by requesting that if Applicants are “aware of any cited reference from among the information disclosures of ... [previous IDS submission] that are ‘material,’ applicants should make that reference known to the examiner.” (Office Action, p. 2, ln. 13 to p. 3, ln. 2).

However, the *J.P. Stevens* case provide absolutely no support for the Examiner’s proposition that Applicants should explicitly state which submitted are “material” to the patentability of any pending claim of the present application. As stated above, Applicants have already submitted all references that are known to Applicants and those individuals identified in 37 C.F.R. § 1.56(a) which may be relevant to the claims of the present application. Applicants assert that there is no legal duty, either via 37 C.F.R. or pursuant to any case law, that requires Applicants to make the specific identification requested by the Examiner. Applicants complied with all requirements under 37 C.F.R. § 1.56 to provide the submission as set forth therein, and pursuant to 37 C.F.R. §§ 1.97 and 1.98.

Finally, the Examiner points to *In re Multidistrict-Litig. Involving Forst Patent*, 540 F.2d 601, 604 and other similar cases as providing that “misrepresentation is material if it makes it impossible to the Patent Office fairly to access [the patent] application against the prevailing statutory criteria.” Then, based on this case, the Examiner contends that “the submission of voluminous documents in the instant information disclosure statements (here in access of 80 documents) make it difficult, and likely impossible, for the Patent Office to

fairly assess applicants' [sic] application against the prevailing statutory criteria." Office Action, p. 3, lns. 3-11).

Applicants respectfully assert that *In re Multidistrict-Litig. Involving Forst Patent* case relied on by the Examiner again address completely different situation form that of the present application. In the cited case, there was a "misrepresentation" that made by applicants of the subject application, and the case addressed when such "misrepresentation" was material. In the present situation, **there is no "misrepresentation" provided to the Patent Office**, as Applicants submitted the information known to them and all individuals identified in 37 C.F.R. 1.56(a). Simply because Applicants did not or even required to state that any reference (or part thereof) is material (as Applicants are clearly authorized to do under the statutory law and case law of the United States), it can in no way be said that such submission is a "misrepresentation."

Further, because Applicants submitted a large number of references and pieces of information, such fact does not relieve the duty on the Patent Office to diligently assess each such reference as its applicability to the pending claims of the above-identified application. Applicants submitted all reference and information for the present application in full compliance with the laws of the United States and 37 C.F.R. to appropriately bring such references to the attention of the Patent Office. With such task accomplished successfully, the Patent Office has a duty to determine the applicability of such references to the pending claims, and inform applicant of the same. This duty cannot be removed when there are a large number of submitted references and information.

Thus, Applicants assert that any the above-referenced statement by the Examiner regarding the alleged impropriety of the previously-submitted Information

Disclosure Statements for the present application are inappropriate, and should be withdrawn.

III. OBJECTION TO THE DRAWINGS SHOULD BE WITHDRAWN

In the Office Action, the Examiner objected to the drawings, and requested that Figs. 1-3 and 8 be labeled with a legend "Prior Art." As the Examiner shall ascertain, new Figs. 1 and 2 are submitted herewith on a "Replacement" sheet to substitute these figures for the originally-filed Figs. 1 and 2. However, Applicants respectfully assert that the originally-filed Figs. 3 and 8 should not include such legend, at least because certain exemplary features associated with the exemplary embodiments of the invention described in the above-referenced application are shown therein. Accordingly, the objection to the drawings should be withdrawn.

IV. OBJECTIONS TO THE CLAIMS SHOULD BE WITHDRAWN

Claims 48, 56, 62, 68-70 and 84 stand objected to due to minor informalities. As the Examiner shall ascertain, these claims have been amended above to remove any such informalities. Accordingly, the objections to claims 48, 56, 62, 68-70 and 84 are now moot, and should therefore be withdrawn.

V. REJECTION UNDER 35 U.S.C. § 112 SHOULD BE WITHDRAWN

Claims 54, 76 and 90 stand rejected under 35 U.S.C. § 112, first paragraph as being allegedly non-enabling. In particular, the Examiner states that the use of a hologram has not been described in the specification of the above-referenced application.

As the Examiner shall ascertain, claims 54, 76 and 90 have been amended above to remove any reference to the "hologram." Accordingly, the 35 U.S.C. § 112, first paragraph rejection of claims 54, 76 and 90 is now moot, and should therefore be withdrawn.

VI. REJECTIONS UNDER 35 U.S.C. § 103(a) SHOULD BE WITHDRAWN

Claims 1-53, 55-75, 77-89 and 91-97 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,687,010 issued to Horii (the "Horii Patent"), in view of Erdelyi et al., J. Vac. Sci. Technol., B 15(2), March/April 1997, pp. 287-292 (the "Erdelyi Publication"). Claim 54, 76 and 90 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Horii Patent and the Erdelyi Publication, in view of International Patent Publication No. WO 99/44089 (the "089 Publication")..

The present application was filed as a national phase application of English-language International Patent Application No. PCT/US03/00699 (the "International Application") on January 11, 2003. Accordingly, even without claiming priority from the provisional U.S. Patent Application No. 60/347,528, the effective filing date of the present application is the filing date of the International Application, i.e., January 11, 2003. The Horii Patent issued on February 3, 2004, and thus is believed to be used by the Examiner as a reference under 35 U.S.C. § 102(e) for rejecting the claims of the present application. Accordingly, pursuant to 37 C.F.R. § 1.131, the Horii Patent can be antedated by filing a declaration establishing that the date of the present invention was earlier than the effective 35 U.S.C. § 102(e) date of the Horii Patent. (See 37 C.F.R. § 1.131).

The application which matured into the Horii Patent was filed with the U.S. Patent and Trademark Office on September 7, 2000, and claimed priority from Japanese

Patent Application Nos. 11-256294 and 2000-078743 filed on September 9, 1999 and March 21, 2000, respectively. According to 35 U.S.C. § 102(e) and M.P.E.P. 706.02(f)(1)(B), the effective § 102(e) filing date of the Horii Patent is the date the application for the Horii Patent was filed with the U.S. Patent and Trademark Office, i.e., *September 7, 2000*.

Accordingly, Applicants submit herewith a declaration pursuant to 37 C.F.R. § 1.131 executed by the inventors of the present application in which it is confirmed that the invention recited at least in currently-pending independent claims 48, 62, 70 and 84 of the above-referenced has been invented by Applicants and reduced to practice prior to September 7, 2000, i.e., the effective § 102(e) filing date of the Horii Patent. Accordingly, the Horii Patent is not applicable for rejecting independent claims 48, 62, 70 and 84 and claims which depend therefrom under 35 U.S.C. § 102(e) and also under 35 U.S.C. § 103(a). Further, without combining with the Horii Patent, the Erdelyi Publication and the '089 Publication fail to teach or suggest the subject matter recited in independent claims 48, 62, 70 and 84 and the claims which depend therefrom, and the Examiner does not contend that they do.

Therefore, Applicants respectfully assert that the Horii Patent has been antedated, and cannot be combined with the Erdelyi Publication and the '089 Publication fail to teach or suggest the subject matter recited in independent claims 48, 62, 70 and 84. Thus, the §103(a) rejections of these claims and the claims which depend there from should be withdrawn.

VII. NEW CLAIMS 98-107

New claims 98-107 have been added above to recite additional subject matter for Examiner's consideration. Support for these new claims can be found in the specification and the drawings. Applicants respectfully assert that the subject matter recited in these new claims is patentable over the art relied on by the Examiner for rejecting the previously-pending claims of the above-referenced application. A conformation of allowability of these new claims is thus respectfully requested.

VIII. CONCLUSION

In light of the foregoing, Applicants respectfully submit that pending claims 48-108 are in condition for allowance. Prompt consideration, reconsideration and allowance of the present application are therefore earnestly solicited.

Respectfully submitted,

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